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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/659,599	09/11/2000	Glenn H. McGall	2719.2001-000	4766

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EXAMINER

EPFS FORD, JANET L

ART UNIT	PAPER NUMBER
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1635

DATE MAILED: 11/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No. 09/659,599	Applicant(s) MCGALL, GLENN H.	
	Examiner Janet L. Epps-Ford, Ph.D.	Art Unit 1635	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 10 October 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 14 July 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See attached.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: Claims 1-23, and 30-38 remain rejected for the reasons of record set forth in the action mailed 4-09-03.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____.

DETAILED ACTION

Response to Arguments

Claim Rejections - 35 USC § 103

1. Claims 1-23, and 30-38 remain rejected under 35 U.S.C. 103(a) as being unpatentable over McGall et al. (5,412,087; US'087) in view of McGall et al. (WO 98/39348 A1; WO'98).
2. Applicant's arguments filed 10-12-03 have been fully considered but they are not persuasive. Applicants traverse the instant rejection on the grounds that none of the protecting groups recited in the present claims fall within the core structure of a nitrobenzylic compound. Contrary to Applicant's assertions, although specific nitrobenzylic compounds are described in one particular embodiment of the McGall et al. (US'087) reference, the entirety of the McGall et al. (US'087) reference can not be construed as being limited to wherein the compounds of the invention are limited to the examples of nitrobenzylic compounds (see col. 8, lines 25-33) listed in the McGall et al. (US'087) reference. It is specifically stated that the caging groups used in the method of McGall et al. (US'087) are photoactivatable, wherein cages formed by these groups are photosensitive protecting groups that are activatable by low energy ultraviolet or visible light. Moreover, McGall et al. (US'087) state that "the above description is intended to be illustrative and not restrictive," (col. 12, lines 13-21) and that "[C]learly, many photosensitive protecting groups are suitable for use in the present method." (col. 8, lines 34-35) Furthermore, in regards to the "core structure" of nitrobenzylic groups referred to by Applicants, McGall et al. refers to the compounds comprising this structure as "examples of acceptable photosensitive protecting groups." It is clear that the common feature of the nitrobenzylic groups useful in the

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method of McGall et al. (US'087) is not the core structure referred to by Applicants, but their common utility, specifically the ability to be used as photosensitive protecting groups.

It is clear that compounds of the present invention are encompassed by the "core structure" $\text{Ar-C(R1)(R2)-O-C(O)-}$ of the compounds taught by McGall et al. (WO'98). Although Applicants argue that the substituents of the aromatic portion of the protecting groups of McGall et al. (WO'98) are preferably electron-donating groups, therefore one of ordinary skill in the art would not be lead to prepare a protecting having an electron withdrawing group such as a nitro group. However, contrary to Applicant's assertions, McGall et al. (WO'98) clearly state that the Ar group of the disclosed compounds is preferably a p-nitrophenyl, and the like, and further states that in particular groups such as 4-nitrophenyl are also included (see page 6, lines 20-29). Moreover, substitutions of the Ar group may be mono-, di- or tri-substituted, independently, with alkyl, lower-alkyl, or a nitro group (*inter alia*; see page 6, lines 1-4). These substitutions are all considered to be functionally equivalent substituents that would produce a functional photocleavable group.

Applicant's arguments do not take the place of evidence, that the combination of the McGall et al. (US'087) and McGall et al. (WO'98) references would not have motivated one of ordinary skill in the art at the time of filing to modify the teachings of McGall et al. (US'087) et al. with the teachings of McGall et al. (WO'98), in the making of the compounds according to the present invention having a formula according to M-Y, and the methods of attaching a molecule to a support according to the present invention.

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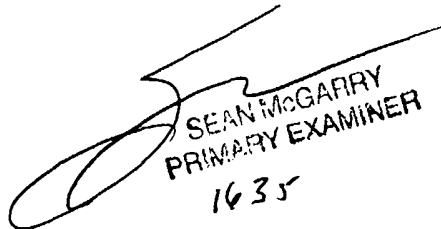
3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janet L. Epps-Ford, Ph.D. whose telephone number is 703-308-8883. The examiner can normally be reached on Monday-Thursday, 8:30 AM - 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John L. LeGuyader can be reached on 703-308-0447. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Janet L. Epps-Ford, Ph.D.
Examiner
Art Unit 1635

JLE


SEAN MCGARRY
PRIMARY EXAMINER
1635